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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. 416

IN THE MATTER OF THE

APPLICATION OF ANDREW ALFORD

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

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Andrew Alford prays that this Court grant rehearing of its order of November 19, 1962, denying the petition for writ of certiorari and that a writ of certiorari issue to review the judgment of the Court of Customs and Patent Appeals in the above-entitled case as prayed for in the petition filed September 6, 1962, herein.

Additional Question Presented

5. Whether the provisions of 35 U.S.C. § 103 prescribe different conditions for patentability for application by the Patent Office and its principal reviewing Article III court, the Court of Customs and patent Appeals, than these provisions prescribe for all other Article III courts.

Reasons for Granting Rehearing and Issuing the Writ

1. At the time of this Court's order of November 19, 1962, we were not aware of the contents of the report to the Commissioner of Patents on the 1961-62 management survey of the Patent Office printed by the Senate Subcommittee on Patents, Trademarks and Copyrights and prepared under the direction of Hon. Earl W. Kintner, former chairman of the Federal Trade Commission.[1] Although the report contained 179 recommendations for improving the Patent Office,[2] it regarded the substance of question 5 presented herein as perhaps the most far reaching and fundamentally important question which the report could raise. The report stated under the heading "THE MAJOR QUESTION":

> It is unfortunate that laws passed under the constitutional power to "promote the progress of science and the useful arts by securing . . . to inventors the exclusive rights to their . . . discoveries" seem to leave open a first question far more fundamental than Office operation, but bearing importantly thereon.
>
> Is the patent system primarily for the benefit of the inventors? Of attorneys? Of industry? Or is it primarily for the benefit of the public, and are patents to inventors merely a quid pro quo to encourage contribution to the common knowledge and welfare?
>
> Converted to terms of Office operation, that question

[1] Study Prepared for the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary pursuant to S. Res. 267, 87th Cong., 2d Sess. (1962), hereafter referred to as *1962 Senate Study*. The United States Patent Quarterly advance sheets for November 5, 1962 reported Senator McClellan's October 25, 1962 announcement of publication of this study. We received a copy of the Study on December 6, 1962 in response to our order of November 13, 1962.

[2] *Id.* 1-11.

becomes this: Where doubt arises as to whether an alleged invention lies (1) within the field of proper patent protection to an inventor, or (2) within the field of accumulated public knowledge reserved to the 180,000,000 members of the public how and by what standards should that doubt be resolved? Should the Office issue the patent if possible, to give the inventor his day in court? Or does the statutory "presumption of validity" of 35 U.S.C. 282 raise by necessary implication a duty in the Patent Office to establish a reasonable basis for that presumed validity? If it does, what constitutes a reasonable basis? Should the test be, "Will it hurt anyone?" or should it be, "Is it patentable?" How good a patent is really wanted? The lack of a clear answer to this question is thought by many to underlie many of the Office difficulties today. Perhaps it is the most far reaching and fundamentally important question this report can raise. Is an answer to this question necessary? And if so, how, by administrative, legislative, or other action, can the answer best be given?[3]

The question posed in that Senate Study made at the request of the Commissioner of Patents[4] is whether the statute makes it easier for the Patent Office to grant a valid patent than for the courts to uphold its validity. The characterization of the Patent Office dilemma in this report contradicts the position set forth in the Brief for the Commissioner filed in this case. This brief argues that because of the statutory presumption of validity, it is not surprising courts look to beneficial results derived from a patented combination to sustain the Patent Office's decision to confer a patent. This brief then states that though the results

[3] *Id.* 121.
[4] *Id.* v-vi.

achieved in the courts of appeals and Supreme Court decisions in conflict with the decision of the majority below was the only factor in support of patentability, we cannot seriously contend that a conflict exists because only a factual inquiry is involved.[5] No factual disputes are involved. The question of law involved is whether a finding of new and unexpected results characterizing the admittedly novel combination sought to be patented given no legal significance by the majority below and by the Patent Office, but recognized as meeting a rather severe test of patentability by this Court and other article III courts for over a century, must be given controlling effect once the Patent Office has granted a patent but can be ignored by the Patent Office and the Court of Customs and Patent Appeals in determining whether a patent should be granted by relying upon a bootstrap lifting argument that the claimed new combination is structurally obvious now that the inventor teaches what a great improvement in results is achieved with but a seemingly slight change in structure.

That is, the Brief for the Commissioner says that a court can rely only on a factual finding of beneficial results derived from a novel combination in making the legal conclusion that the conditions for patentability have been met by a combination already patented, but the Patent Office can ignore the same factual finding and make the opposite legal conclusion that the conditions for patentability have not been met if an applicant is seeking a patent on that combination. This position in the Brief for the Commissioner is impossible to resolve with the inability of the Report to the Commissioner to answer "THE IMPORTANT QUESTION". For although that report acknowledges that the Patent Office is in a dilemma as to whether it should issue a patent which it suspects the courts might not

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[5] Brief for the Commissioner pp. 8-9 n. 5.

uphold, a necessary corollary of its recommendations that the Patent Office look to court decisions and opinions in an effort to achieve patents of uniform quality[6] is that if tests applied in court decisions require a conclusion that the conditions for patentability have been met, the patent ought to be granted. And applying the settled severe test set forth in numerous court decisions that the achievement of new and unexpected results with a novel combination meets the condition for patentability, necessitates a determination that petitioner's application for patent should be granted.

When a question presented is answered definitely in a Brief for the Commissioner of Patents with an answer outside the permissible range of answers contemplated in a report to the Commissioner of Patents on a study supervised by a recognized administrative expert who headed the Federal Trade Commission, an important question which the Patent Office could not answer, it cannot be seriously contended that the question does not meet the criteria for review in this Court.

2. In our reply brief[7] we discussed the untenability of the Government's contention that this Court is without jurisdiction to review decisions in the Court of Customs and Patent Appeals without there questioning the Government's assertion, "It is necessary . . . to establish that Congress intended to vest . . . jurisdiction in this Court."[8] That assertion ignores the presumption of appellate jurisdiction in this Court to review decisions of lower Article III courts embodied in the policy and language of Article III, section 2. The constitutional policy is to promote uniform standards of federal law for application by all tribunals concerned, whether federal or state courts or

[6] *1962 Senate Study 72-73.*
[7] Reply Brief for Petitioner pp. 1-3.
[8] Brief for the Commissioner p. 6.

administrative agencies. The constitutional language authorizes Congress to make the conditions for and exceptions from the appellate jurisdiction of this Court. If this Court is to be deprived of jurisdiction to review cases on patent appeals in the Court of Customs and Patent Appeals, it is necessary to establish that Congress intended to deprive this Court of such jurisdiction. A question presented involving an understanding of the important constitutional provision conferring appellate jurisdiction on this Court to review decisions of lower Article III courts surely falls into the most important category of questions justifying review in this Court.

3. In disagreeing with the conventional classification of the two cultures as (1) scientific, the understanding of things, and (2) liberal, the understanding of men, Vannevar Bush recently set forth his concept of how the two cultures should be defined.[9] He defined the first type of culture simply as "the basis of wisdom." He said:

> . . . Wisdom requires far more than extensive superficial knowledge, it requires also the ability to reason, whether by strict logic or by balance of evidence amid contradictions, an ability which is attained only by thinking intensively and exhaustively, surrounded by keen minds doing the same thing, competitors struggling for mastery, in a tough, demanding subject.[10]

Resolution of the questions presented requires a minimum of the scientific culture, defined as one of the two cultures by the classicists. The record in this case is full but short. The mechanical structure of the invention is

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[9] Vannevar Bush, *Two Cultures* in 65 TECHNOLOGY REVIEW 21 (November 1962)

[10] *Ibid.* Dr. Bush could state no concrete definition of the second culture, but said that it has nothing whatever to do with utility. *Id.* 23.

easy to grasp. Understanding the philosophy of the invention does not require a degree in physics or electronics.

But settling the questions presented does require an abundance of the first culture defined by Vannevar Bush. We think that the conciseness of the record should enable the Court to devote the bulk of its intensive thought available for this case to mastering the tough demanding subject of the constitutional, statutory, political, social and economic policies behind the conditions for patentability so as to lay out guide lines which aid businessmen, inventors, the Patent Office and the courts in dealing with inventions and patents with greater certainty to lessen the institution of patent litigation and the cost of those cases which do reach the courts.

Conclusion

For the reasons set forth above and in connection with the petition for writ of certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Customs and Patent Appeals.

Respectf ully submitted,

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Certificate of Counsel

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

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